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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/899,494	07/05/2001	Tomihiko Azuma	14744	2580
23389	7590	10/19/2004	EXAMINER	
SCULLY SCOTT MURPHY & PRESSER, PC 400 GARDEN CITY PLAZA GARDEN CITY, NY 11530			SALL, EL HADJI MALICK	
			ART UNIT	PAPER NUMBER

2157

DATE MAILED: 10/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/899,494

Applicant(s)

AZUMA, TOMIHIKO

Examiner

El Hadji M Sall

Art Unit

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

1. DETAILED ACTION

This action is responsive to the application filed on July 5, 2001. Claims 1-10 are pending. Claims 1-10 represent method of vicariously executing translation of electronic mails for users, and apparatus, system and medium therefor.

2. Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5 and 7-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Nishino et al. U.S. 5,295,068.

Nishino teaches the invention as claimed including apparatus for registering private-use words in machine-translation/electronic-mail system (see abstract).

As to claim 1, Nishino teaches a method of vicariously executing translation of electronic mails for users, comprising a translating step of translating a part or all of the contents of an electronic mail sent from a user who is a subscriber of an Internet connection provider, an electronic mail addressed to the user or both of these electronic mails at the provider side (figure 1; column 1-2, line 68-1-3, Nishino discloses a machine-translation/electronic-mail system which permits the user to register and

search the private-use word, thereby permitting the user to obtain a desired translation result).

As to claim 2, Nishino teaches the method as claimed in claim 1, further comprising a translation judging step of judging whether the user-sending or user-addressed electronic mail corresponds to an electronic mail which is predetermined by the user to be translated, on the basis of combination information of the mail address of the user and the mail address of a communication partner of an electronic mail which is predetermined by the user to be translated, and information on the electronic mail addresses of the transmission source and destination of a user-sending electronic mail or a user-addressed electronic mail, said translation judging step being antecedent to said electronic mail translating step (column 4, lines 2-8, Nishino discloses in the temporarily-registering means 9, the text except the definition of the private-use word is judged to be source text to be translated, and is therefore issued from the temporarily-registering means 9 to the translation means 6 of the machine-translation/electronic-mail system 1)

As to claim 3, Nishino teaches a provider machine comprising electronic mail transmitting means for transmitting, to the mail address of a communication partner of an electronic mail or a terminal device of the user, a translated electronic mail containing a translation text obtained by translating through the provider a part or all of the contents of an electronic mail sent from a user who is a subscriber of an Internet connection provider, an electronic mail addressed to the user or both of these electronic mails (figure 1; column 1-2, line 68-1-3, Nishino discloses a machine-translation/electronic-mail system which permits the user to register and search the private-use word, thereby permitting the user to obtain a desired translation result).

As to claim 4, Nishino teaches the provider machine as claimed in claim 3, further comprising:

information storage means for storing at least combination information of the mail address of the user and the mail address of a communication partner of an electronic mail, which is predetermined by the user to be translated (figure 1, item 9)

translation judging means for judging whether the user-sending or user-addressed electronic mail corresponds to the electronic mail which is predetermined by the user to be translated, on the basis of the electronic mail addresses of a transmission source and a transmission destination of a user-sending electronic mail or user-addressed electronic mail and the combination information of said information storage means (column 4, lines 2-8, Nishino discloses in the temporarily-registering means 9, the text except the definition of the private-use word is judged to be source text to be translated, and is therefore issued from the temporarily-registering means 9 to the translation means 6 of the machine-translation/electronic-mail system 1).

As to claim 5, Nishino teaches the provider machine as claimed in claim 3, further comprising:

information storage means for storing combination information of the mail address of the user, the mail address of a communication partner which is predetermined by the user to be translated, and a language for a translation destination (figure 1, item 9; column 3, lines 15-20, Nishino discloses The word-definition recognition means 8 of system 1 recognizes information as to a source-language word and a target-language word by extracting a portion defining a word (i.e., a private-use word which is used by the user, translated into his requested meaning in the target language) from a text of the electronic mail 3);

translating means for translating a part or all of the contents of an electronic mail sent from the user or addressed to the user in the language of the translation destination on the basis of the combination information of said information storage

means (figure 1, item 6; column 3, lines 30-36, Nishino discloses a translation means 6 of the machine translation/electronic-mail system 1 translates the text (except a word-definition sentence) in the source language into a desired meaning in the target language, with reference to the private-use word dictionary and the standard dictionary, to obtain a translation result); and

translated electronic mail creating means for creating a translated electronic mail containing a translated text translated by said translating means (figure 1, item 5).

As to claim 7, Nishino teaches a terminal device comprising at least translated electronic mail receiving means for receiving a translated electronic mail transmitted from said electronic mail transmitting means of said provider machine as claimed in claim 3 (figure 1, item 5).

As to claim 8, Nishino teaches a system comprising said provider machine as claimed in claim 3, and said terminal device as claimed in claim 7 (figure 1).

As to claim 9, Nishino teaches a medium for carrying a computer readable and executable program for executing said translating step in the electronic mail translating method as claimed in claim 1 (figure 2, item 11).

As to claim 10, Nishino teaches a medium for carrying a computer readable and executable program for executing said translation judging step in the electronic mail translating method as claimed in claim 2 (figure 2, item 11; figure 3; column 6, lines 52-56, Nishino discloses in the word-definition recognition portion 37, sentences contained in the text portion S2 of the electronic mail S1 are judged line by line as to whether each of the sentences constitutes a proper object of translation or a definition

statement of the private-use word. If the sentence contained in the text portion S2 constitutes the definition statement of the private-use word, the contents of the definition statement are extracted to determine a meaning S3-1 in the target language of the private-use word (hereinafter referred to as the target-language meaning S3-1 of the private-use word))

3. Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nishino et al. U.S. 5,295,068.

Nishino teaches the invention substantially as claimed including apparatus for registering private-use words in machine-translation/electronic-mail system (see abstract).

As to claim 6, Nishino teaches the provider machine as claimed in claim 4, further comprising:

translating means for translating a part or all of the contents of an electronic mail sent from the user or addressed to the user in the language of the translation destination on the basis of the combination information of said another information storage means (figure 1, item 6; column 3, lines 30-36, Nishino discloses a translation means 6 of the machine translation/electronic-mail system 1 translates the text (except a word-definition sentence) in the source language into a desired meaning in the target language, with reference to the private-use word dictionary and the standard dictionary, to obtain a translation result); and

translated electronic mail creating means for creating a translated electronic mail containing a translated text translated by said translating means (figure 1, item 5).

Nishino does not teach explicitly another information storage means.

However, Nishino teaches an external unit, which can be used to do the same functionality as another information storage means (figure 2, item 24)

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Nishino by specifying the external memory unit as another information storage means since the same functionality of storing combination information of the mail address of the user, the mail address of a communication partner which is predetermined by the user to be translated, and a language for a translation destination is achieved. One would be motivated to do so to allow the private-use word dictionary being temporarily used in the translation as the private-use word dictionary (see abstract).

5. Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to El Hadji M Sall whose telephone number is 703-306-4153. The examiner can normally be reached on 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on 703 308-7562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

El Hadji Sall
Patent Examiner
Art Unit: 2157



SALEH NAJJAR
PRIMARY EXAMINER

